



14

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : John F. Conroy
Serial No. : 10/068,983
Filed : February 11, 2002
Title : RECESSED BOTTLE STORAGE

Art Unit : 3637
Examiner : Janet M. Wilkins

Mail Stop Appeal Brief-Patents

Commissioner for Patents
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COMPLETE NEW BRIEF ON APPEAL

This complete new Brief on Appeal is being filed in response to the Notice of Non-Compliance with 37 C.F.R. §1.192(c) mailed February 18, 2003. Please note that the original Brief on Appeal was filed on November 28, 2003.

(1) Real Party in Interest

The real party of interest in the application is John F. Conroy, a real person residing in California.

(2) Related Appeals and Interferences

The applicant is not aware of any appeals and/or interferences related to the application.

(3) Status of Claims

Claims 1-32 are pending in the case.

Claims 10-12, 17-19, 24, and 27 were not elected in the Amendment and Response filed June 16, 2003 and have been withdrawn from consideration.

Claim 13 has been withdrawn from consideration by the Examiner upon review of the application.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

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John F. Conroy

Claims 1-9, 14-16, 20-23, 25, 26, and 28-32 have been finally rejected in the Office action dated September 9, 2003.

(4) Status of Amendments

An Amendment under 37 C.F.R. §1.116 amending claim 20 was filed on November 28, 2003. The Amendment was entered for purposes of appeal by way of the Advisory Action mailed December 30, 2003.

The appendix of claims in this brief reflects the changes to claims in that Amendment.

(5) Summary of Invention

Background

The generally accepted manner for storing wines is to rack a wine bottle on its side so the cork stays in contact with wine. Although storing a bottle on its side occupies a larger footprint, it also prevents the cork from drying out and air from entering the bottle.

Wine is often stored in a wine cellar where large amounts of space are devoted to the storage of wine. However, many people do not have a cellar or large amounts of space to devote to the storage of wine. Moreover, even those individuals with a wine cellar often store a few wine bottles in the kitchen or other room above the cellar, since the wine is then on hand and easily accessed.

The Present Application

The application is directed to apparatus and processes for the storage of wine and other bottles recessed in walls. Recessed bottle storage removes at least a portion of the rack and the bottle from the room where the bottle is stored. This reduces the amount of space required for storage and bottles may be efficiently and properly stored in rooms that are easily accessible or in homes that do not have a cellar. Moreover, appropriately-sized racks may efficiently exploit the common on center spacing between adjacent 2x4 wood or other studs.

Applicant's teachings can be understood by reference to, e.g., FIGS. 1 and 2. A bottle rack is mountable recessed in a wall for the space-saving storage of bottles. See p. 2, lines 13-14. The space-saving can be accomplished by storing bottles with their long axis substantially

parallel to the plane of the wall. See FIGS. 1, 2, 3, 4, and 6. The bottle rack can include a housing that houses bottle cradles. See p. 2, lines 14-15. Bottle cradles cradle bottles to maintain the corks or other stoppers in contact with a stored liquid without the bottles rolling. See p. 2, lines 21-23.

(6) Issues

The issues to be decided on appeal are:

I. Are claims 1-7, 9, 16, 20-23, 25, 26, 31 and 32 improperly rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,707,125 (hereinafter "Coglin")?

II. Are claims 28-30 improperly rejected under 35 U.S.C. §103(a) as obvious over Coglin in view of U.S. Patent No. 6,361,129 (hereinafter "Boergen")?

At this time, the rejections of claims 8, 14, and 15 under 35 U.S.C. §103(a) as obvious over Coglin in view of Boergen are not presented for review.

(7) Grouping of Claims

Claims 1-9, 14-16, 20-23, 25, 26, and 28-32 do not stand or fall together.

Rather, claims 2-9, 14-16, 20 stand or fall along with independent claim 1;

claims 21, 22, 25-26, 31, and 32 stand or fall together;

claim 23 stands or falls independently; and

claims 29-30 stand or fall along with independent claim 28.

(8) Argument

I. The Rejection of Claims Under 35 U.S.C. §102(b) as Anticipated is Improper

Law: Anticipation

A claim is "anticipated" when a single prior art reference discloses all features spelled out in the claim, either explicitly or inherently. *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 687, 689 (Fed. Cir. 1985); *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991); *Glaverbel Societe Anonyme v. Northlake Marketing & Supply, Inc.*, 45 F.3d 1550 (Fed. Cir. 1995).

"It is well settled that anticipation under 35 U.S.C. §102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

Claim 1 is Not Anticipated by Coglin

Claim 1 relates to a storage space that includes a wine rack having a wine cradle. The wine rack is configured to be at least partially recessed in a wall. The wine cradle is configured to store a wine bottle with a stopper in contact with a stored wine.

In dealing with both wine racks and wine cradles, claim 1 is separately patentable from claim 23 (which deals with a wine rack including a wine cradle) and claims 21, 22, and 25 (which deal with bottle racks configured to be at least partially recessed in a wall or a means for racking a bottle at least partially recessed in a wall). Claim 1 is also separately patentable from claim 28, which deals with a method including storing a bottle in a bottle rack.

The Examiner has characterized the cabinets of Coglin as wine racks, and the cabinet shelves as wine cradles. Applicant disagrees with these characterizations.

Coglin lacks any mention whatsoever of wine racks, but rather deals with generic cabinets for shelving general household items. Although bottles may be shelvable in Coglin's generic cabinets, the mere fact that a cabinet shelves a bottle does not transform the cabinet into a wine rack. Further, the cabinet shelves of Coglin are flat to provide for shelving of general household items such as books, ornaments, trophies, rifles, linens, tools, or supplies. Flat shelves do not provide the cradling action of wine cradles. Thus, neither the wine rack feature nor the wine cradle feature is shown by Coglin and anticipation has not been established.

The Response to Arguments section of the action mailed September 9, 2003 contends that the term "wine rack" is a mere statement of intended use and hence not entitled to consideration in determining patentability. Applicant respectfully disagrees. The mere fact that a cabinet shelves a wine bottle does not transform the cabinet into a wine rack, nor does a wine rack transform into a cabinet if it is used to store household goods. The distinct features of wine racks and cabinets ensure the two are differentiated regardless of use.

Further, the Examiner's interpretation of the term "wine rack" to encompass anything that "may be used to store a wine bottle" eviscerates the plain meaning of the term. For example, when a supermarket stores wine inventory in shipping crates, do these crates become "wine racks" merely due to their use to store a wine bottle? If the wine inventory is moved onto display shelves, do the display shelves suddenly move into the state of being "wine racks" while the emptied shipping crates are no longer "wine racks?" When a consumer purchases a wine and stores the wine in a motor vehicle while picking up the dry-cleaning, does the motor vehicle itself become a "wine rack" merely due to its use in storing a wine bottle?

The Response to Arguments section also highlights that the wine cradle feature is missing from Coglin. In particular, it is contended that Coglin's shelves can be "used to support a bottle." However, **claim 1 does not recite a "support."** Rather claim 1 recites a "cradle." The contention that shelves can be used to support a bottle is thus irrelevant since no cradle feature is found in Coglin.

In summary, since features recited in claim 1 are not shown by Coglin, claims 1-9, 13-16, 20 are not anticipated by Coglin.

Claims 21, 22, and 25 are Not Anticipated by Coglin

Claims 21 and 22 relate to a storage space that includes a bottle rack. The bottle rack is configured to be at least partially recessed in a wall. In claim 21, the bottle rack is configured to store a bottle having a long axis substantially parallel to the plane of the wall. In claim 22, the bottle rack is of unitary construction.

Claim 25 relates to a storage space that includes a means for racking a bottle at least partially recessed in a wall with a long axis substantially parallel to the plane of the wall.

Coglin lacks any mention whatsoever of bottle racks or means for racking, but rather deals with generic cabinets for shelving general household items. Although bottles may be shelvable in Coglin's generic cabinets, the mere fact that a cabinet shelves a bottle does not transform the cabinet into a bottle rack or a means for racking, nor does a bottle rack or a means for racking transform into a cabinet if it is used to store household goods. The distinct features of bottle racks, means for racking and cabinets ensure that they are differentiated regardless of use. Further, the Examiner cannot eviscerate the plain meaning of the terms in forming the rejection.

Since features recited in claims 21, 22, and 25 are not shown by Coglin, claims 21, 22, 25-26, 31, and 32 are not anticipated by Coglin.

Claim 23 is Not Anticipated by Coglin

Claim 23 relates to a wine rack that includes a housing and a wine cradle. The housing is adapted for mounting at least partially into a building wall. The wine cradle is positioned generally within the housing and configured to store a wine bottle having a cork in contact with wine.

Coglin lacks any mention whatsoever of a wine cradle. The flat cabinet shelves of Coglin can support wine bottles, but flat cabinet shelves do not provide the cradling action of wine cradles. Any contention that shelves can be used to support a bottle is thus irrelevant and no cradle feature is found in Coglin.

Since features recited in claim 23 are not shown by Coglin, Applicant respectfully submits that claim 23 is not anticipated by Coglin.

II. The Rejection of Claims Under 35 U.S.C. §103(a) as Obvious is Improper

Law: Obviousness

"It is well established that the burden is on the PTO to establish a prima facie showing of obviousness," *In re Fritsch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (C.C.P.A., 1972).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of

making the combination.” *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

“It is well established that there must be some logical reason apparent from the evidence or record to justify combination or modification of references.” *In re Regal*, 526 F.2d 1399 188, U.S.P.Q.2d 136 (C.C.P.A. 1975).

“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.” *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

Claim 28 is Not Obvious over Coglin in View of Boergen

Claim 28 relates to a method including storing a bottle in a bottle rack. The bottle rack is at least partially recessed in a wall. The bottle is stored with a long axis substantially parallel to the plane of the wall.

Neither Boergen nor Coglin describes or suggests storing a bottle in a bottle rack at least partially recessed in a wall. Boergen deals with a self-supporting, dual purpose cooler and display device. See FIG. 1 of Boergen. Coglin lacks any mention whatsoever of bottle racks, but rather deals with generic cabinets for shelving general household items. Although bottles may be shelvable in Coglin’s generic cabinets, the mere fact that a cabinet shelves a bottle does not transform the cabinet into a bottle rack, nor does a bottle rack transform into a cabinet if it is used to store household goods. The distinct features of bottle racks and cabinets ensure that they are differentiated regardless of use. Further, the Examiner cannot eviscerate the plain meaning of the terms in forming the rejection.

Applicant : John F. Conroy
Serial No. : 10/068,983
Filed : February 11, 2002
Page : 8

Further, even if one were to take the rods from Boergen and, without any suggestion founded in the prior art, stick them in Coglin's generic cabinets, one would still not be able to practice the method of claim 28. In particular, Boergen's rods are cantilevered (i.e., supported at only one end) from the rear wall of the device toward the front. See, e.g., col. 2, line 5-19 of Boergen. Mounting forwardly-projecting rods in Coglin's generic cabinets would still not allow one to store a bottle with a long axis substantially parallel to the plane of the wall, as claimed. Finally, there is no suggestion founded in the cited art to modify the orientation or support of the Boergen's rods to arrive at a bottle rack that would allow one to practice the claimed method.

Accordingly, Applicant submits that claims 28-30 are also allowable.

Applicant submits, therefore, that claims 1-32 are allowable and that the Examiner erred in rejecting Applicant's claims and should be reversed.

A check for the brief fee of \$165 was enclosed with the appeal brief filed November 28, 2003. No additional brief fee is believed to be due.

This complete new Brief on Appeal is being filed in response to the Notice of Non-Compliance with 37 C.F.R. §1.192(c) mailed February 18, 2003. Since this complete new Brief on Appeal is being filed less than one month from the mailing date of the Notice, no extension of time fees are believed to be due.

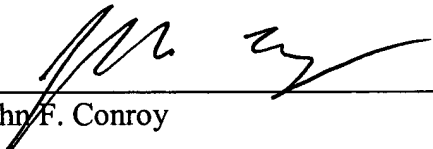
Applicant : John F. Conroy
Serial No. : 10/068,983
Filed : February 11, 2002
Page : 9

As described in the enclosed transmittal letter, in the course of preparing the complete new brief in compliance with 37 C.F.R. §1.192(c), Applicant has noticed that the original application included two claims numbered "18." Excess claims fees for the additional claim were not rendered at the time of filing. Therefore, excess claims fees in the amount of \$9 for one additional dependent claim are filed herewith.

Respectfully submitted,

Date: _____

3/16/04



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Appendix of Claims

1. A storage space comprising:
a wine rack configured to be at least partially recessed in a wall and including a wine cradle configured to store a wine bottle with a stopper in contact with a stored wine.
2. The storage space of claim 1 wherein the wine rack comprises an enclosure.
3. The storage space of claim 2 wherein the enclosure comprises a side wall.
4. The storage space of claim 3 wherein at least one of the side walls defines a fastener hole.
5. The storage space of claim 3 wherein the side wall supports the wine cradle.
6. The storage space of claim 3 wherein the enclosure comprises a second side wall.
7. The storage space of claim 6 wherein the side walls are spaced apart to substantially traverse a distance separating opposing faces of wall studs.
8. The storage space of claim 7 wherein the side wall are spaced apart to substantially traverse one of a 37 cm distance and a 57 cm distance.
9. The storage space of claim 1 wherein the wine rack is of unitary construction.
10. (Withdrawn)
11. (Withdrawn)
12. (Withdrawn)

13. (Withdrawn)

14. The storage space of claim 1 wherein the wine cradle defines a depression dimensioned to support the wine bottle without rolling.

15. The storage space of claim 14 wherein the wine cradle comprises a pair of spaced apart, substantially parallel rods, wherein the depression is defined between the pair of rods.

16. The storage space of claim 1 wherein the wine rack further comprises a lip extending laterally outward from a front of the wine rack.

17. (Withdrawn)

18. (Withdrawn)

19. (Withdrawn)

20. A building comprising the storage space of claim 1.

21. A storage space comprising a bottle rack configured to be at least partially recessed in a wall and to store a bottle having a long axis substantially parallel to the plane of the wall.

22. A storage space comprising a bottle rack configured to be at least partially recessed in a wall, the bottle rack being of unitary construction.

23. A wine rack comprising:
a housing adapted for mounting at least partially into a building wall, the housing including a rear wall joined to a forwardly projecting top wall, bottom wall, and pair of side walls to define a forwardly open interior chamber;

a wine cradle configured to store a wine bottle having a cork in contact with a stored wine, the wine cradle positioned generally within the housing; and
a lip extending laterally outward from the top wall, bottom wall, and side walls.

24. (Withdrawn)

25. A storage space comprising a means for racking a bottle at least partially recessed in a wall and having a long axis substantially parallel to the plane of the wall.

26. The storage space of claim 25 wherein the means for storing further comprises a means for cradling a bottle having a stopper in contact with a stored liquid.

27. (Withdrawn)

28. A method comprising storing a bottle in a bottle rack at least partially recessed in a wall with a long axis substantially parallel to the plane of the wall.

29. The method of claim 28 further comprising storing a wine bottle in the bottle rack with a cork in contact with a wine in the wine bottle.

30. The method of claim 28 further comprising mounting the bottle rack to a wall stud forming the wall.

31. The storage space of claim 21, wherein the bottle rack is configured to store the bottle having a stopper in contact with a stored liquid.

32. The storage space of claim 25, wherein the means for racking the bottle racks the bottle having a stopper in contact with a stored liquid.